

REMARKS

The above amendments and these remarks are responsive to the Office action mailed April 17, 2006. Claims 1-32 are pending in the application. Claims 1-6, and 8-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Smirnov (U.S. Patent Application Publication No. US 2001/0041496 A1). Claims 30-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by Speasl et al. (U.S. Patent No. 6,901,971). Claims 7, 23, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Speasl et al. Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Melzer et al. (U.S. Patent No. 6,712,667). Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Laurienzo (U.S. Patent No. 6,224,455). Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Speasl et al. and further in view of Chan (U.S. Patent Application Publication No. 2002/0086607). Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Speasl et al. and further in view of Chan and Melzer et al.. Claims 27 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Speasl et al. and further in view of Chan and Laurienzo.

In view of the amendments above, and the remarks below, applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Rejections under 35 USC § 102

Claims 1-6 and 8-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Smirnov.

Applicants respectfully traverse this rejection, particularly in view of the amendments above. In order to anticipate a claim, a reference must disclose each and every element recited in

the claim. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). Applicants respectfully submit that Smirnov fails to disclose or suggest the subject matter of independent claims 1 and 11 and their dependent claims. Specifically, although Smirnov appears to teach the use of sensors to determine environmental characteristics, such as detecting humidity with an appropriate type of sensor, these characteristics are not compared *between* sensors. Applicants maintain their assertion that Smirnov merely uses changes within a single sensor, namely temporal changes, to influence the behavior of the toy (see paragraphs 76-79).

However, in the interest of expedient prosecution, applicants have amended claims 1 and 11 to recite a reference sensor spaced away from a breath sensor in a location protected from air exposure. Support for these amendments is found in paragraphs 17 and 18 of applicants' specification.

Thus, since claims 1 and 11 recite at least the aforementioned elements not disclosed by Smirnov, the reference does not and cannot anticipate the breath-sensitive toy of claims 1 or 11. For at least these reasons, applicants respectfully request the withdrawal of the rejection of claims 1 and 11 under 35 U.S.C. § 102(b). Claims 2-6 and 8-10 depend from and further limit claim 1 and thus should be allowed when amended claim 1 is allowed. Claims 12-20 depend from and further limit claim 11 and thus should be allowed when amended claim 11 is allowed.

Claims 30-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by Speasl et al.

Without acknowledging the propriety of this rejection, applicants have amended claim 30 to recite that the second sensor is responsive to an environmental factor at a second location of the toy that is protected from air exposure. In contrast, Speasl et al. merely discloses mounting sensors to internal portions of a transportable shell to measure environmental characteristics at

different positions within the shell (the '971 patent, col. 4, line 63 – col. 5, line 3). Not only does Speasl et al. fail to disclose or suggest the subject matter of claim 30, but it would also be disadvantageous for such a sensor to be placed in a location protected from air exposure since the objective of Speasl et al. is to monitor environmental conditions during transport of sensitive goods, therefore necessitating accurate readings (the '971 patent, col. 2, line 35 – col. 3, line 18).

Thus, since claim 30 recites at least the aforementioned element not disclosed by Speasl et al., the reference does not and cannot anticipate the environment-sensitive toy recited in claim 30. For at least these reasons, applicants respectfully request the withdrawal of the rejection of claim 30 under 35 U.S.C. § 102(e). Claims 31 and 32 depend from and further limit claim 30 and thus should be allowed when amended claim 30 is allowed.

Rejections under 35 USC § 103

Claims 7, 23, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Speasl et al.

Applicants traverse this rejection. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings, there must be a reasonable expectation of success, and the prior art reference (or references, when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2142.

Smirnov discloses a talking toy for storing and reproducing audible messages. In contrast, Speasl et al. is directed to remote sensing of the internal environmental characteristics

of transportable containers, such as shipping containers for semiconductor wafers. Applicants assert there is no motivation, other than applicants' disclosure, to combine the teachings of Speasl et al. with Smirnov.

Further, applicants submit that Speasl et al. is non-analogous art to the present application. For this reference to be analogous prior art it must either be from the same field of endeavor as applicant's invention, or reasonably pertinent to the particular problem to be solved. See, e.g., *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 863 (Fed. Cir. 1993), (memory for industrial computers not analogous art to memory for personal computers), see also MPEP § 2141.01(a). Neither of these conditions is met. The present application is directed to the field of interactive children's toys, while Speasl et al. is directed to the field of manufacture of semiconductor wafers. The particular problem solved by the present application is determining the presence of breath and other forms of human input. Speasl et al. solves the problem of remote sensing of internal environmental conditions of shipping containers. A person of ordinary skill in the art would not look to Speasl et al. either as from the same field or as solving a reasonably pertinent problem.

Even assuming such a combination is made, the combination of Smirnov and Speasl et al. fails to teach or suggest all the claim limitations. In particular, Speasl et al. discloses humidity sensors that may include more than one channel for sensing humidity (the '971 patent, col. 6, ll. 1-10). In the context of electrical components, as discussed in Speasl et al., a "channel" refers to a specified frequency range for the transmission and reception of electromagnetic signals (American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000). Consequently, the sensor of Speasl et al. may be able to collect data from multiple locations or data of multiple types. In contrast, applicants use of "channel" refers to a physical structure as

described in paragraphs 31 and 32 and shown in Figs. 7 and 8 of applicants' specification.

Claim 7 has been amended and now recites that each channel includes a breath sensor located therein. Claim 23 recites a plurality of breath sensors, each placed in a channel of the toy. Claim 29 has been amended to recite that the reference sensor is positioned in a location protected from air exposure. In addition to differences in sensor location, neither Smirnov nor Speasl et al., alone or in combination, disclose, teach, or suggest comparisons between sensors, as recited in claims 7 and 23.

Consequently, Smirnov and Speasl et al., considered alone or in combination, fail to disclose, teach, or suggest the subject matter of claims 7, 23 and 29. For at least these reasons, applicants respectfully request the withdrawal of the rejection of claims 7, 23 and 29 under 35 U.S.C. § 103(a).

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Melzer et al.

Applicants traverse this rejection. Melzer et al. discloses a toy including word objects, word bubble objects, character objects, and accessory objects. Articulation points are provided so that the objects may be pivoted relative to one another (the '667 patent, col. 2, line 54 – col. 3, line 15). The objects are formed of a magnetic sheet material to allow repositioning of the objects (the '667 patent, col. 3, line 46 – col. 4, line 18). In versions depicting a Greek theme, the illustrations on the objects may include depictions of instruments; however, no musical tones are produced (the '667 patent, col. 8, ll. 41-45).

As mentioned above, Smirnov discloses a talking toy for storing and reproducing audible messages, yet fails to disclose or suggest comparisons between sensors. As noted by the

Examiner, Smirnov further fails to disclose or suggest a sounding accessory in the form of a pan flute.

Further, applicants assert there is no motivation, other than applicants' disclosure, to combine the teachings of Melzer et al. with Smirnov. Melzer et al. merely teaches themed illustrations of musical instruments rather than a musical toy in the form of a pan flute capable of producing a musical tone; whereas Smirnov teaches toys that pronounce various phrases when the user activates the toy.

The combination of Smirnov and Melzer et al. fails to teach or suggest all the claim limitations. For at least these reasons, applicants respectfully request the withdrawal of the rejection of claim 21 under 35 U.S.C. § 103(a).

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Laurienzo.

Applicants traverse this rejection. Laurienzo discloses a toy figure having a transparent simulated harmonica through which light may be transmitted. Smirnov discloses a talking toy for storing and reproducing audible messages. Applicants assert there is no motivation, other than applicants' disclosure, to combine the teachings of Laurienzo with Smirnov. For at least these reasons, applicants respectfully request the withdrawal of the rejection of claim 22 under 35 U.S.C. § 103(a). Moreover, claim 22 depends indirectly from claim 11 and should therefore be allowed when claim 11 is allowed.

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smirnov in view of Speasl et al. and further in view of Chan. Claims 25 and 26 were rejected over the references as

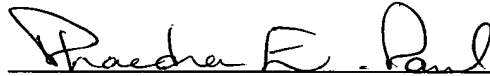
applied to claim 23 and further in view of Melzer et al. Claims 27 and 28 were rejected over the references as applied to claim 23 further in view of Laurienzo.

As previously discussed, applicants assert there is no motivation, other than applicants' disclosure, to combine the teachings of Speas et al. with Smirnov. This deficiency is not corrected by Chan, Melzer et al., or Laurienzo. For at least these reasons, applicants respectfully request the withdrawal of the rejection of claims 24-28 under 35 U.S.C. § 103(a). Moreover, claims 24-28 depend from claim 23 and should therefore be allowed when claim 23 is allowed.

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Phaedra E. Paul

Registration No. 56,366

Customer No. 23581

Attorney for Applicant(s)/Assignee

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on June 23, 2006.



Merissa R. Thompson